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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,804	09/30/2003	Matthias Boese	W0029/7005	2223

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EXAMINER	
FLETCHER III, WILLIAM P	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/675,804	BOESE, MATTHIAS	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/30/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's status inquiry filed March 3, 2006 is noted.

2. Claims 1-21 are pending.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on September 30, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

5. The drawings were received on September 30, 2006. These drawings are acceptable.

Claim Objections

6. Claims 4 and 6 are objected to because of the following informalities: These claims should, apparently, read "...wherein applying said quantity of sample in liquid state on said at least one sample position...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 8 and 18 are rejected under 35 U.S.C. 112, first paragraph**, because the specification, while being enabling for an IR-transparent material as sample carrier, does not reasonably provide enablement for the any and all transparent materials encompassed

by the broad recitation of "transparent material." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The specification discloses only that the sample carrier may be an IR-transparent material or a roughened metal (see page 8 of the specification). The language of claims 8 and 18 broadly encompass more than these materials and the specification does not enable one of ordinary skill to determine which of these other materials is suitable for use in the invention without undue experimentation.

9. **Claims 10 and 20 are rejected under 35 U.S.C. 112, first paragraph**, because the specification, while being enabling for a roughened metal surface as the sample carrier, does not reasonably provide enablement for the any and all roughened surfaces encompassed by the broad recitation of "a plate whose surface is roughened." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. As noted above, the specification discloses only that the sample carrier may be an IR-transparent material or a roughened metal (see page 8 of the specification). The language of claims 10 and 20 broadly encompass more than these materials and the specification does not enable one of ordinary skill to determine which of these other materials is suitable for use in the invention without undue experimentation.

# # #

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 2 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A. The term "fine" in claims 2 and 15 is a relative term which renders the claim indefinite. The term "fine" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear just what the term is meant to imply: the degree of resolution, degree of intricacy of pattern, etc. Further, it is unclear what degrees of fineness are included within the scope of the invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 1, 4, 5, 11, 12, 13, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Eipel et al. (US 2003/0143316 A1).**

A. This reference teaches a method for the application of a quantity of a liquid sample or samples to a substrate in the form of a pattern of extremely small liquid quantities or dots spaced apart from each other [0002, 0015, and 0021].

B. While this reference does not explicitly disclose subsequent spectroscopic analysis, it is the examiner's position that this limitation, appearing only in the preamble, does not carry any patentable weight because: (1) this limitation is not essential to understand limitations or terms in the claim body; (2) the preamble has not yet been relied upon during prosecution to distinguish the invention over the prior art; and (3) the claim body describes a complete invention (method) such that deletion of the preamble phrase does not effect the recited method steps of the claimed invention.[1]

C. While this reference does not explicitly teach drying of the sample applied to the substrate, it is the examiner's position that such drying is inherent as a certain evaporation of the liquid into the ambient atmosphere is inherent and such anticipates the broad recitation of "drying."

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. **Claims 2, 3, 6-10, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eipel et al. (US 2003/0143316 A1).**

A. With respect to claims 2, 3, 15, and 16, the amount, arrangement, and density of the dots on the sample carrier are result-effective variables effecting the amount of sample that can be analyzed. Consequently, it would have been obvious to one of

[1] *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 62 USPQ2d 1781 (CAFC 2002)

ordinary skill in the art to optimize these result-effective variables by routine experimentation, absent evidence of their criticality.[2]

B. With respect to claims 6 and 14, it is well-known in the coating art to repeat application of a coating material in order to build up a desired thickness. Such would have been obvious to one of ordinary skill in the art.

C. With respect to claims 7 and 17, it would have been obvious to one of ordinary skill in the art to heat the sample carrier at least as part of a cleaning/pre-coating process.

D. With respect to claims 8-10 and 18-20, it is the examiner's position that these are common and conventional substrates that would have been obvious to one of ordinary skill in the art.

Conclusion

16. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

[2] MPEP 2144.05

272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Phillip Fletcher III
Patent Examiner (FSA), USPTO
Art Unit 1762

Fredericksburg, VA
September 28, 2006